

REMARKS

The present amendment is submitted in an earnest effort to establish an issue for appeal or place this case in immediate condition for allowance.

1. The final action has repeated, in large measure, a rejection made by the Examiner and has treated Applicants arguments as overcome, allegedly because some of the prior art additives "would be expected to include spaces or be porous." Alternatively, it is the Examiner's position that materials disclosed in the prior art "would be expected to be porous".

As the Examiner will see below, these are taken as admissions that the materials in the prior art are not disclosed to be porous.

Since those materials are not disclosed to be porous, there is no reason to believe that they "would be expected to be porous".

It is, therefore, Applicants' position that the Examiner is relying strictly upon hindsight from the instant disclosure to justify the rejection, and that is improper.

Since the Examiner's action in making the communication

of 31 May 2005 final is not based upon the steps taken by Applicants, this amendment is enterable as a matter of right and the application should be allowed or Applicant should be permitted to appeal at this stage without the need for the filing of a request for continued examination.

2. With respect to the informalities on pages 6, 7, 11 13 and 18, the Examiner is advised that those informalities do not appear in the papers filed by Applicant and appear to result exclusively from the scanning processes. The changes, therefore, should be made by the office. Nevertheless, in the present amendment by a paragraph by paragraph change, the specification has been altered. The specification changes do not involve the introduction of new matter.

3. The Examiner seems to indicate that a new IDS may be beneficial in the case and by that, Applicant understands a new PTO-1449 form which is comprehensive and includes full details with respect to the publications AS, AT, AU, AW and AX, in spite of the fact that a prior PTO-1449 has been properly initialed. There is

enclosed just such a PTO-1449 form.

4. To avoid any misunderstanding as to what this invention is about, claim 1 has been altered to make clear that the solid porous pieces are porous granules. Since that subject matter appeared in claim 5, claim 5 is now cancelled.

5. The rejection of claims on Nashiwa et al is respectfully traversed. The Examiner has stretched the projectile shown by Nashiwa into a porous solid by relying on the fact that at column 4, line 54, the reference mentions fireproof paper. Since the claims are now limited to porous solid granules of the additive and fireproof paper does not fall into that category and there is no other reason for believing that anything porous is disclosed in Nashiwa et al, the rejection of claim 1 or any other claim in the case on Nashiwa must be withdrawn.

As noted above, there is nothing in Nashiwa to suggest that the shell may be granular and porous or that there is anything both porous and granular in the additives supplied by Nashiwa et al.

The Examiner has relied upon Hunter Patent 5,110,351. In

that patent manganese oar is added to the bath. There is not a word in Hunter et al to indicate that the oar is porous. The crushing of pieces makes them smaller but it does not make them porous. There is nothing in Hunter which would suggest that porous granules are to be added to the melt.

There is nothing in Sherwood which would suggest that porous solids be added to the melt.

There is nothing in Patent Abstracts of Japan 01129925 that would suggest that the calcium added to the molten steel in granular or lump form should be or is porous.

There is nothing in Patent Abstracts of Japan 55107718 which suggests that additives be used which are porous.

There is nothing in Bogan Patent 5,228,902 which discloses that a desulfurizing agent be added which would be porous.

There is nothing in Rossborough Patent 5,358,550 which discloses that molten steel under vacuum can be treated by feeding pieces of a porous degasification promoting solid granulate into the molten steel. For the sake of interest, it may be observed that Rossborough desulfurizes pig iron.

It follows then that the references do not teach alone, collectively or in any combination that additives for the degasification of steel under vacuum should be porous.

It has been noted earlier that when a body of art has a glaring gap, like the lack of a disclosure that the degasification solid be porous, the reliance on hindsight is similarly inappropriate. Here the Examiner is relying on Applicants own teachings to support a rejection which cannot properly be made from the references themselves (see Panduit Corp. v. Dennison Manufacturing Company 227 USPQ 337).

The rejection cannot stand and its withdrawal is requested together with allowance of all of the claims now in the case.

Respectfully submitted,
The Firm of Karl F. Ross P.C.



By: Herbert Dubno, Reg. No. 19,752
Attorney for Applicant

db-

DATED: August 29, 2005
5676 Riverdale Avenue Box 900
Bronx, NY 10471-0900
Cust. No.: 535
Tel: (718) 884-6600
Encls: Abstract of Disclosure
PTO-1449 Form